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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/569,313

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Roger Braun

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SUITE 1201

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EXAMINER

DICUS, TAMRA

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/569,313	<b>Applicant(s)</b> BRAUN, ROGER	
	<b>Examiner</b> TAMRA L. DICUS	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/22/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-37 and 39-65 is/are pending in the application.
- 4a) Of the above claim(s) 50-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-37 and 39-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

The claim objection is withdrawn.

All prior art rejections are withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20—49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 20 (amended) does not have the proper support in the original specification as filed because the specification does not provide any teaching or discussion on one application side only or its usage with Applicant's claimed wooden material panel. For instance, the original disclosure, see page 6, 3<sup>rd</sup> paragraph of Applicant's instant specification, states the plastic surface coating is two layers, on one side or different sides, different meaning the front and rear sides. Thus, omitting a rear side now is considered

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new matter by exclusion of the possible rear side application. Any negative limitation or exclusionary proviso must have basis in the original disclosure. These new limitations do not have basis in the original disclosure.

Additionally, claim 41 has claimed one layer of plastic "has been" applied (again, "has been" is past tense and should be in the present) onto each main surface of the panel, which appears indefinite as claim 20 states the layers of plastic are only on a front side, assuming a front side is equivalent to a main surface.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 20-40, and 42-49 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6077613 to Gaffigan in view of US 20040197468 (Geel et al.) or alternatively in view of US 4,163,813 to Sheets et al.**

Gaffigan teaches Claim 20, a wooden material panel (of wood material 60, FIG. 4 and associated text)l, including a multilayer surface coating

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(polymeric matrix 20 – single or blends of such polymers as polyethylene or ethylene vinyl acetate-classed elastomerics (what happens after is inherent to the nature of the resin-re claim 49) or alternatively (and thus not required on the front side) backings 10 or 30, FIG. 4 and associated text, -of polyester, polypropylene) applied at least on parts of the panel, said surface coating comprising at least one layer of plastics, polymeric matrix coating 20 has a Shore hardness A of less than 75, and also a range of 65 to 80, falling within or at Applicant's range of having a Shore hardness A up to 90 (claim 20) and claims 21-23. Shore hardness A of less than 75, falls within the claimed range of claims 23-25. Should the select surface coatings be the polymers of the backing layers, while not stated what the Shore Hardness values are, it is inherent as the material is the same. The panel is a floor or ceiling panel. Any of the layers are considered bonding agent layers as said materials are adjacent and thus bond with the surrounding layers. See 3:20-30, 4:5-20, 4:20-55, and 5:1-30, 50-65. Claims 20-30, 44, and 47-48 and are met. To claim 31, see 4:40-60. Claims 38-40 and 42 multilayers are identified as set forth above. Claims 40 and 42 are not in the present tense – e.g. “have been applied”. To claim 43, because 20 and 10 are different materials, they would inherently have different Shore values. The reference is anticipatory.

The reference does not teach the instant invention with sufficient specificity to constitute anticipation. The reference fails to teach the thicknesses as recited per claims 32-37. However, does teach adjusting

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thickness to be relatively thin (see 5:10-35). It would have been obvious to one of ordinary skill in the art to produce a thickness as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. 617 F.2d 272,205 USPQ 215(CCPA 1980). See also MPEP § 2144.05 II (B). Thickness affects the strength of the membrane taught by Gaffigan.

Gaffigan teaches the claimed invention above.

RE claims 20, and 45-46-varnish and paint layers, Gaffigan doesn't teach, however Geel teaches paint (varnish is an obvious alternate for improving appearance) for applying to polyester mat ceiling panels as external decorative markings. See [0004,0017,0025].

Sheets also teaches decorative compositions of varnish or paint to give wood panels protection and color for decoration. See Abstract, 1:15-20, 2:65-66, and 4:15-25.

It would have been obvious to one having ordinary skill in the art to have modified the panel of Gaffigan to include paint or varnish layers for improving the protection or decorative nature of panels as provided by Geel or Sheets. See above.

**Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6077613 to Gaffigan in view of US 20040197468 (Geel et al.) or**

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**alternatively in view of US 4,163,813 to Sheets et al. and further in view of US 5,569,505 to Nichols.**

The combination teaches the claimed invention above.

Gaffigan doesn't teach the plastic coating surrounding the panel as in claim 41. Further RE Claim 41 is not in the present tense – e.g. “have been applied”.

However, Nichols teaches in general moldings (plastic) wrapped with plastic decorative skin layers to make the molding appear seamless used in decorative panels (see 1:5-10, 3:23-35).

It would have been obvious to one having ordinary skill in the art to have modified the combination and wrap the plastic layers around the panel of Gaffigan in order for the entire article to not have seams yielding a more desirable appearance as taught by Nichols above.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues the insulation membrane of Gaffigan doesn't insulate against ambient sound, however, this is not claimed. Further, any amount of material will inherently provide some degree of sound insulation.

The claims as argued are to new matter and should be removed.

Applicant is reminded that he should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06.

Cautionary note: upon removal of the new matter (see below) the prior rejection will reapply and will be made FINAL.

Applicant argues that Gaffigan doesn't have only a layer on a front side of the panel; however, Gaffigan does teach backing layer is optional, and thus need not be required. All other references are used for similar reasons as presented prior.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In



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no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Ruthkosky/  
Supervisory Patent Examiner, Art Unit 1795

Tamra L. Dicus  
Examiner, Art Unit 1794

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